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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,511	02/26/2004	Bruce C. Campbell	86927CPK	6480

7590 12/28/2005

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,511

Applicant(s)

CAMPBELL ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/26/04, 7/28/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

I. Claims 1-21, drawn to recording element, classified in class 428, subclass

32.17.

II. Claims 22-25, drawn to method of printing, classified in class 347,

subclass 105.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, (i.e., the product can be used as a wall paper).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Chris P. Konkol on 12/15/2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 22-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12, 14-18 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Campbell et al. (US 6,698,880 B1)

8. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any

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invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Campbell discloses an ink jet recording element having a porous substrate and a surface layer, which traps pigment particles (hereinafter referred as pigment trapping layer) over the porous substrate (abstract). The porous substrate has pores with a total void volume of at least $20 \text{ cm}^3/\text{m}^2$ (col. 3, line 28). The limitations of claims 5-11 are disclosed in col. 3, line 51 thru col. 5, line 8). The pigment trapping layer is equivalent to the claimed porous ink receptive layer and is disclosed in col. 7, lines 22-42. The pigment trapping layer further comprises a cationic mordant (col. 8, line 34).

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1, 6, 12-14 and 17-20 rejected under 35 U.S.C. 102(a) as being anticipated by Wexler (US 6,695,447 B1).

Wexler discloses an ink jet recording element comprising a support, an ink carrier liquid receptive layer on the support, a dye trapping layer on the ink carrier liquid receptive layer and an ink transporting layer on the dye trapping layer (abstract). The dye trapping layer is equivalent to the claimed porous ink receptive layer and is disclosed in col. 3, line 41 thru col. 4, line 58. The support can be porous such as paper (col. 6, line 15).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 6,695,447 B1) in view of Campbell et al. (US 6,698,880 B1).

Wexler discloses an ink jet recording element comprising a support, an ink carrier liquid receptive layer on the support, a dye trapping layer on the ink carrier liquid receptive layer and an ink transporting layer on the dye trapping layer (abstract). The dye trapping layer is equivalent to the claimed porous ink receptive layer and is disclosed in col. 3, line 41 thru col. 4, line 58). The support can be porous such as paper (col. 6, line 15).

Campbell discloses an ink jet recording element having a porous substrate and a surface layer, which traps pigment particles (hereinafter referred as pigment trapping layer) over the porous substrate (abstract). The porous substrate has pores with a total void volume of at least 20 cm³/m² (col. 3, line 28). The limitations of claims 5-11 are disclosed in col. 3, line 51 thru col. 5, line 8). The pigment trapping layer is equivalent to the claimed porous ink receptive layer and is disclosed in col. 7, lines 22-42. The pigment trapping layer further comprises a cationic mordant (col. 8, line 34).

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Wexler and Campbell are analogous art because they are from the same field of endeavor that is the ink jet recording element art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the porous substrate of Campbell with the invention of Wexler in order to readily absorb the amount of ink applied to create various images (see col. 3, line 45 of Campbell).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.S.

December 23, 2005.


BETELHEM SHEWAREGED
PRIMARY EXAMINER